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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,297	01/10/2006	Job Cornelis Oostveen	NL 030807	7965
24737 7590 07/12/2010 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510				
EXAMINER				
PICH, PONNOREAY				
ART UNIT		PAPER NUMBER		
2435				
MAIL DATE		DELIVERY MODE		
07/12/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/564,297

Applicant(s)

OOSTVEEN ET AL.

Examiner

Ponnoreay Pich

Art Unit

2435

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-14 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date 6/10.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: _____.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/29/10 has been entered.

Claims 1-4, 8-14, and 18-21 were examined.

Information Disclosure Statement

The IDS submitted on 6/29/10 was considered.

Response to Amendments and Arguments

Applicant's amendments and arguments directed at the amended claims were fully considered. Applicant's request to hold the double patenting rejection in abeyance is noted. The 101 and 112 rejections made in the last Office action are withdrawn due to applicant's amendments. Applicant's arguments with respect to the rejection of claims under 102 were considered, but not persuasive.

Applicant argues Rhoads does not disclose a trigger time point corresponding to a segment of the multimedia signal. The examiner respectfully disagrees. Rhoads's fingerprints are derived from the content as represented in time (paragraph 14). The fingerprints are obtained from windows of time associated with the content (paragraph 21). Each of these windows of time can be considered a trigger time point since the fingerprint obtained from a window is used as a trigger by Rhoads to initiate responses

(paragraph 27). These windows can further be considered to be corresponding to segments of the multimedia signal since they are derived from segments of the multimedia signal/content based on a unit time (paragraph 21).

Applicant argues Rhoads does not describe the triggered responses of Rhoads as corresponding to any time point within a multimedia signal. Applicant states that mere identification of a song does not constitute a trigger time point within the song at least because identification of the song may occur independently of any time point within the song. The examiner respectfully disagrees.

The identification of the song depends on the fingerprint formed from a time window associated with the song (paragraph 21). Since that fingerprint is associated with the time window of the song and is used to trigger a response (paragraph 27), the triggered response corresponds to the time point/time window within the multimedia signal/song since until that time window occurs, the fingerprint cannot be identified to trigger an action.

Applicant argues that Rhoads's responses are merely triggered upon identification of a song, but does not correspond to a trigger time point within a song. As pointed out above already, the fingerprint are obtained from a time window associated with the song (paragraph 21) and since the fingerprint is used to trigger a response (paragraph 27), the time window can be considered a trigger time point within a song. Claims are interpreted in light of the specification and this teaching by Rhoads appears to be identical to what is disclosed in applicant's specification as far as the examiner can tell.

Applicant argues that triggering a response once a song is identified has nothing to do with a time point within a multimedia signal. The examiner respectfully disagrees. As pointed out above already, the fingerprint used to identify the song is formed from a time window of the song (paragraph 21), thus in triggering the response by using a fingerprint which is itself derived from a time point within the song does in fact have everything to do with a time point within a multimedia signal/song. Again, what Rhoads does appears to be identical to what is disclosed in applicant's specification and claims are interpreted in light of the specification.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-14 and 18-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

1. Claim 11 is directed towards what applicant calls a device which comprises "a microprocessor-controlled fingerprint module..." and "a microprocessor-controlled database module...". As understood by one of ordinary skill in the art, the term module could reasonably be interpreted to refer to software modules. All software modules are microprocessor controlled modules and as written it does not appear that the microprocessors which controls the fingerprint module and database module are actually considered part of the claimed device. As such, it would appear that what applicant calls a device in claim 11 is nothing more than software modules per se. Software by itself does not fall within any of the four

statutory categories of invention and by itself is incapable of any functionalities.

As such, claim 11 is not statutory.

2. Claim 12 additionally recites the (software) device of claim 11 comprising a database, which one skilled should appreciate could still refer to software per se (i.e. Microsoft Access is a software database). As such, since claim 12 is still directed towards software per se, claim 12 is also not statutory.
3. Claim 13 additionally recites the (software) device of claim 11 additionally comprising a transmitter. However, there does not appear to be anything recited in claim 13 which would require one to interpret the transmitter as anything other than a software transmitter (i.e. Microsoft Outlook is a software transmitter used to transmit emails). Since claim 13 is still directed towards software per se, claim 13 is not statutory.
4. Claims 14 and 18-20 are also not statutory because they also appear to be directed towards software per se as nothing within these claims imply hardware.
5. Applicant must claim at least one hardware component as part of the device of claim 11 to overcome the above rejections under 35 USC 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8-14, and 18-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rhoads et al (US 2002/0032864).

Claims 1, 11, and 21:

As per claim 1, Rhoads discloses:

1. Providing a trigger time point of a plurality of trigger time points within a multimedia signal, the trigger time point corresponding to a segment of a plurality of segments of the multimedia signal (paragraphs 14, 21, and 27—*Each short time window from which a fingerprint can be derived is considered a trigger time point because the fingerprint derived from the time window belonging to the audio track is used to trigger any number of different responses. Note that plural fingerprints can be derived from plural time windows of the same audio track. This means that an audio track has a plurality of trigger time points.*).
2. Providing a representation of action that corresponds to the trigger time point, where the trigger time point indicates a time point within the multimedia signal at which the action is to be triggered during a playback of the multimedia signal (paragraph 27).
3. Deriving a fingerprint based on the segment of the multimedia signal (paragraphs 14 and 21).
4. Associating the derived fingerprint with the action (paragraph 27).

The rejection of claim 1 applies, *mutatis mutandis*, to claims 11 and 21. Claim 11 is directed towards a device comprising a microprocessor-controlled fingerprint module

(i.e. software) and microprocessor-controlled database module (i.e. fingerprint) configured to implement the method of claim 1. One should appreciate that Rhoads's invention is computer implemented, thus the steps of his method are implemented by microprocessor controlled software modules. Claim 21 is directed towards a non-transitory computer readable storage medium having stored thereon instructions for causing the device of claim 21 to implement the method of claim 1.

Claims 2 and 12:

As per claim 2, Rhoads further discloses storing at least one of the derived fingerprint or the representation of the action in a first database (paragraphs 27 and 30-31). The rejection of claim 2 applies, *mutatis mutandis*, to claim 12.

Claims 3 and 13:

As per claim 3, Rhoads further discloses transmitting at least one of the derived fingerprint or the representation of the action to a playback device (paragraph 27). The rejection of claim 3 applies, *mutatis mutandis*, to claim 13.

Claims 4 and 14:

Rhoads further discloses the trigger time point corresponds to at least one of a start of the segment, an end of the segment, a predetermined distance from the start of the segment, or a predetermined distance from the end of the segment (paragraphs 14 and 21).

Claims 8 and 18:

Rhoads further discloses wherein the multimedia signal is at least one of an audio signal or video signal (paragraphs 21 and 34).

Claims 9 and 19:

Rhoads further discloses wherein the action is selected from a group consisting of: retrieving and displaying additional information on a display, retrieving and playing additional information via a speaker, playing another multimedia signal instead of the multimedia signal for a period of time, interrupting the playback of the multimedia signal, executing control commands, and preparing a system for user inputs (paragraph 27).

Claims 10 and 20:

As per claim 10, Rhoads further discloses storing at least one of the derived fingerprint or the representation of the action in a second database; and wherein the derived fingerprint is at least one of an audio fingerprint or a video fingerprint (paragraphs 9, 14, 21, and 31). The rejection of claim 10 applies, *mutatis mutandis*, to claim 20.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 11, 10, 20, 3, 13, 4, 14, 8, 18, and 21 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 15, 2, 16, 3, 17, 4, 18, 14, 28, and 29 respectively of copending Application No. 10/566,003. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The above claims of the '003 application are anticipated by the above claims of the current application

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is (571) 272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ponnoreay Pich/
Primary Examiner, Art Unit 2435